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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The American Fertility Society

Serial No. 74/568,765

Mark Sommers and Doug Rettew of Finnegan, Henderson,
Farabow, Garrett & Dunner, L.L.P. for The American Fertility
Society.

Thomas Wellington, Trademark Examining Attorney, Law Office
104 (Sidney I. Moskowitz, Managing Attorney).

Before Simms, Hanak and Hairston, Administrative Trademark
Judges.

Opinion by Hairston, Administrative Trademark Judge:

The American Fertility Society seeks to register the
term AMERICAN SOCIETY FOR REPRODUCTIVE MEDICINE on the
Supplemental Register for "association services, namely
promoting the interests of the reproductive medicine

industry."¹ Although registration was originally sought on the Principal Register under Section 1(b) of the Trademark Act, applicant amended the application to the Supplemental Register on August 11, 1995. Use of the term since November 8, 1994 was alleged. Applicant amended the application to the Supplemental Register in response to a refusal to register under Section 2(e)(2) of the Act on the ground that the matter sought to be registered was primarily geographically descriptive of applicant's services.

Registration has been finally refused under Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), in view of applicant's failure to comply with the requirement to disclaim SOCIETY FOR REPRODUCTIVE MEDICINE apart from the mark as shown. The Examining Attorney maintains that SOCIETY FOR REPRODUCTIVE MEDICINE is generic of applicant's services.

Both applicant and the Examining Attorney have filed briefs and were present at the oral hearing.

At the outset, we note applicant's objection to the refusal on "procedural grounds." (Brief, p. 2) Applicant contends that the refusal is in contravention of TMEP §1105.05(f)(ii) which provides, in relevant part, that:

The Office will not issue any requirements

¹ Application Serial No. 74/568,765 filed September 1, 1994. While it appears that applicant has changed its name to the American Society for Reproductive Medicine, no formal change of name has been submitted.

or refusals concerning matters which could or should have been raised during initial examination, unless the failure to do so in initial examination constitutes a clear error.

Whether applicant's objection is well taken would involve a determination of whether the Examining Attorney's failure to require a disclaimer during initial examination was clear error. The Board recently stated that it will not second guess the Trademark Examining Organization's application of the clear error standard. See *In re Sambado & Son, Inc.*, 45 USPQ2d 1312 (TTAB 1997). Thus, our inquiry on appeal is limited to the underlying substantive refusal.

We turn then to the issue of whether SOCIETY FOR REPRODUCTIVE MEDICINE is generic of applicant's services and must therefore be disclaimed. Our reviewing court in *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 792 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986) states a two-part test for determining whether a term is generic and therefore incapable of distinguishing applicant's services. First, we must ask what is the genus, or class of services to which applicant's services belong. Next, we must ask whether the public understands the term sought to be registered to refer to that genus of class of services. Evidence of the relevant public's understanding of a term may be obtained from any competent source, including dictionaries, newspapers, magazines, trade

journals and other publications. See *In re Northland Aluminum Products, Inc.*, 777 F.2d 1566, 227 USPQ 962, 963 (Fed. Cir. 1985).

In support of the refusal, the Examining Attorney made of record a copy of an entry from Webster's Ninth New Collegiate Dictionary which defines "society" at page 1119 as, inter alia, "a voluntary association of individuals for common ends; esp: an organized group working together or periodically meeting because of common interests, beliefs, or profession."

In addition, the Examining Attorney made of record excerpts of stories retrieved from a search of the NEXIS data base which show that reproductive medicine is a recognized field of medicine. Examples of these excerpts, with *reproductive medicine* highlighted, are set forth below:

. . . given all my life to helping people have children and to work in an academic environment to improve the field of *reproductive medicine*. (The Los Angeles Times, February 27, 1997);

Midwest *Reproductive Medicine*, which has long helped women with infertility problems, now is turning some of its attention to menopause. (The Indianapolis Star, February 19, 1996);

. . . it was babies that were booming as the Center for *Reproductive Medicine* at Swedish Medical Center in Englewood threw a party to celebrate the 1,000th baby born to its infertility program. (Rocky Mountain News, February 17, 1996);

The NU Medical Center offered in vitro fertilization during the 1980's and resumed

the services when the Center for *Reproductive Medicine* was organized about three years ago.
(Omaha World News, February 14, 1996);

Lisa Angerame, spokeswoman with the American Society for *Reproductive Medicine* (ASRM), said 23 states have some kind of law requiring sperm donor screening, but Washington is not among them.
(AIDS Weekly, January 1996).

Also, the Examining Attorney submitted copies of over twenty registrations wherein the word "society" is disclaimed. With his appeal brief the Examining Attorney submitted a copy of any entry from Roget's II The New Thesaurus which defines "association" at page 63 as, inter alia, "a group of people united in a relationship and having some interest, activity, or purpose in common."²

Applicant, in urging reversal of the refusal to register, argues that the evidence of record, which relates to the individual terms, "society" and "reproductive medicine," does not establish that the unitary phrase SOCIETY FOR REPRODUCTIVE MEDICINE is generic of applicant's services. According to applicant, no evidence has been offered that the unitary term SOCIETY FOR REPRODUCTIVE

²Applicant, citing Trademark Rule 2.42(d), has objected thereto, contending in its reply brief that the Examining Attorney has introduced new evidence which was not of record during prosecution. Applicant accordingly moves to strike the definition as untimely. Applicant's request, however, is not well taken and is denied inasmuch as it is well settled that

MEDICINE would be understood by the relevant public to refer to the kind of services offered by applicant. Also, applicant maintains that the NEXIS excerpts, in particular, support applicant's position because the only references which include the unitary phrase SOCIETY FOR REPRODUCTIVE MEDICINE relate to applicant and the use of AMERICAN SOCIETY FOR REPRODUCTIVE MEDICINE.

After careful consideration of the arguments herein, we agree with the Examining Attorney that SOCIETY FOR REPRODUCTIVE MEDICINE is indeed generic of applicant's services. It is evident from the NEXIS excerpts that reproductive medicine is a medical specialty. Indeed, applicant itself has used this expression generically in the description of services in the application. Also, it is clear from the recitation of services that applicant is an association of individuals, i.e., a society, whose common interest or profession is the field of reproductive medicine. Therefore, the designation SOCIETY FOR REPRODUCTIVE MEDICINE aptly names applicant's association, and as such is a generic name of applicant's services. See *In re Association of Energy Engineers*, 227 USPQ 76 (TTAB 1985) [ASSOCIATION OF ENERGY ENGINEERS is the generic designation for an organization of engineers specializing in the field of energy]; *In re National Shooting Sports*

judicial notice may be taken by the Board of any standard

Foundation, Inc., 219 USPQ 1018 (TTAB 1983) [SHOOTING, HUNTING, OUTDOOR TRADE SHOW AND CONFERENCE is apt descriptive name for conducting and arranging trade shows in hunting, shooting and outdoor sports products field]; and In re Career Employment Services, Inc., 219 USPQ 951 (TTAB 1983) [THE PROFESSIONAL HEALTH CARE PEOPLE is generic for providing temporary services for nurses, nurses aides, and other medical personnel]. Here, the combination of the terms "society" and "reproductive medicine" results in a designation, SOCIETY FOR REPRODUCTIVE MEDICINE, which is also generic. See In re Gould Paper Corp., 835 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987) [SCREENWIPE is generic for wipes for cleaning computer and television screens] and In re Associated Theater Clubs Co., 9 USPQ2d 1660 (1988) [GROUP SALES BOX OFFICE is apt descriptive name for theater ticket sales services].

As to applicant's contention that the Examining Attorney has not met his burden of establishing that SOCIETY FOR REPRODUCTIVE MEDICINE is generic because the record does not show that others have used the identical or even similar designations, it is not necessary that the designation in question be the only apt or common name of the goods or services or that the name be universally recognized as such. In re Sun Oil Company, 165 USPQ 718, 719 (Rich, J.,

reference works, including thesauruses.

concurring). Finally, the fact that applicant may be the first and only user of this generic designation does not

justify registration if the term projects only generic significance.³

Decision: The refusal to register is affirmed.

However, this decision will be set aside and the mark published for opposition, if applicant, no later than thirty days from the mailing date hereof, submits an appropriate disclaimer of SOCIETY FOR REPRODUCTIVE MEDICINE.

R. L. Simms

³ Contrary to the dissent's position that there must be evidence of use of the designation--SOCIETY FOR REPRODUCTIVE MEDICINE--"in a generic sense" by others, what the Court stated in Gould, at 1111 in response to a similar argument is instructive:

We agree with Gould that "to refuse registration on the ground that an applicant seeks to register the generic name of the goods, the PTO must show that the word or expression inherently has such meaning in ordinary language, or that the public uses it to identify goods of other producers as well." (citations omitted) We hold, however, that the PTO has satisfied its evidentiary burden if, as it did in this case, it produces evidence including dictionary definitions that the separate words joined to form a compound have a meaning identical to the meaning common usage would ascribe to those words as a compound.

See also *In re Associated Theater Club Co.*, *supra*, holding GROUP SALES BOX OFFICE generic despite the lack of evidence that "group sales" and "box office" were used together by others; and *Turtle Wax, Inc. v. Blue Coral Inc.*, 2 USPQ2d 1534 (TTAB 1987), holding WASHWAX generic despite the fact that there was no evidence of third-party use of this precise designation.

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P. T. Hairston
Administrative Trademark
Judge, Trademark Trial and
Appeal Board